



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,495	12/13/2000	Louis A. Schick	20-LC-2099/624226.289	3646

7590 10/08/2004

Enrique J. Mora, Esquire
Beusse, Brownlee, Bowdoin & Wolter, P.A.
390 North Orange Avenue, Suite 2500
Orlando, FL 32801

EXAMINER

FISHER, MICHAEL J

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/736,495

Applicant(s)

SCHICK ET AL. 

Examiner

Michael J Fisher

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/26/01</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4,10,12-14 and 20-25 are rejected under 35 U.S.C. 102(e) as being anticipated by US PAT 6,301,531 to Pierro et al. (Pierro).

As to claims 1,20,21,22, Pierro discloses a method of managing a plurality of mobile assets (title), collecting data (section (a) in claim 1), processing the data to develop historical information regarding usage (sections (c),(d),(e) and (f) in claim 1), using the data to develop a failure prediction (claim 1, section (f)), distributing the information via data link to a global network (col 4, lines 7-9). It would be inherent that such a system would increase the performance and operating life of the mobile asset as this is the object of good maintenance.

As to claim 2, Pierro discloses using environmental data (operating parameters, col 4, lines 24-31).

As to claim 3, Pierro discloses determining a service recommendation based on the actual usage (claim 7, section (e)).

As to claim 4, Pierro discloses recommending services (section (d) in claim 8).

Art Unit: 3629

As to claim 10, Pierro discloses using the data to develop information regarding service functions (claim 1, sections (c)-(f)).

As to claim 12, Pierro discloses identifying trends (claim 1, section (d)), developing a service recommendation (claim 8, section (d)).

As to claim 13, Pierro disclosed the analyzing step as being on-board the mobile asset (col 3, lines 42-45).

As to claim 14, Pierro discloses the analyzing step as being remote from the mobile asset (claim 1, section (a)).

As to claims 23-25, Pierro further discloses a plurality of sensors (claim 5) and memory and data processor for recording data (118).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5-9,11,15-19 and 26-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierro.

As to claims 5,6 and 8, Pierro discloses where the asset should be stopped (claim 7, section (e)), therefore, it would have been obvious to one of ordinary skill in the art to modify the system as disclosed by Pierro by recommending a service center as Pierro discloses determining where to stop the asset and therefore, a close service center would be appropriate.

As to claims 7,18, it is very well known in the art for companies with mobile assets to have an agreement with a particular service agent. Therefore, it would have been obvious to one of ordinary skill in the art to modify the system as disclosed by Pierro by providing a dedicated service chain to be able to get a reduced rate for quantity.

As to claim 9, it would be obvious to one of ordinary skill in the art to use cargo as one of the parameters (claim 5) as cargo affects the weight carried and would therefore, affect engine and suspension performance.

As to claim 11, Pierro does not disclose using the Internet to disseminate information. It is very well known to connect computers to the Internet. Therefore, it would have been obvious to one of ordinary skill in the art to use the Internet to disseminate information as Pierro discloses using a computer (119) and it would make accessing the information more convenient.

As to claims 15-17 and 19, it is very well known in the art for public transportation assets to be compliant with regulatory requirements, to ensure safety. Therefore, it

Art Unit: 3629

would have been obvious to one of ordinary skill in the art to modify the system as disclosed by Pierro by notifying about regulatory requirements to ensure that the company does not get fined for exceeding limits, as Pierro discloses the system as being useful for notifying the user about required maintenance.

As to claims 26,27, it is very well known in the art for companies to establish a cost/benefit analysis to ensure profitability. Therefore, it would have been obvious to one of ordinary skill in the art to use a cost-benefit analysis to ensure profitability for the enterprise.

As to claims 27 and 28, it is inherent that the value of an asset changes with usage and service. Further, it is inherent for companies to assess the value of assets for tax and business purposes. Therefore, it would have been obvious to one of ordinary skill in the art to modify the system as disclosed by Pierro by calculating the value of the mobile assets for tax and business purposes.

As to claim 29, Pierro discloses predicting services based on past services (claim 8, section (d)).

As to claim 30, it is inherent that a company would assess the remaining warranty coverage else the company could pay for a repair that is covered by any warranty.

As to claim 31, warranty coverage is inherently based on service recommendations. For instance, if a warranty requires regular oil changes and the oil is not changed, the warranty could be voided.

Conclusion

Art Unit: 3629

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US PAT 6,480,810 to Cardella et al., Cardella et al. disclose a method of remotely monitoring a fleet, US PAT 6,330,499 to Chou et al., Chou et al. disclose a system and method for vehicle diagnostics and health monitoring.

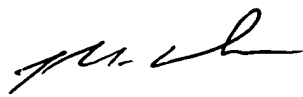
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Fisher whose telephone number is 703-306-5993. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF

10/01/04


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600